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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,328 10/21/99 MCCARTHY F 7528.0002-05

QM22/0827
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EXAMINER

JASTRZAB, J

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 08/27/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/422,328

Applicant(s)

MCCARTHY ET AL.

Examiner

Jeffrey R. Jastrzab

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 25-41 and 45-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 22-24 is/are allowed.
- 6) ☐ Claim(s) 1-21 and 42-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24 and 42-44 drawn to the infarct treatment, classified in class 600, subclass 16.
- II. Claims 25 and 26, drawn to the infarct treatment with a compression member classified in class 600, subclass 16.
- III. Claims 27-38, drawn to the treatment by suturing around the infarct , classified in class 600, subclass 16.
- IV. Claims 39-41 and 74-77, drawn to the enclosure member treatment method, classified in class 600, subclass 16.
- V. Claims 45-54, drawn to the patch and member apparatus, classified in class 600, subclass 16.
- VI. Claims 55-73, drawn to the plural sutures and enclosure member apparatus, classified in class 600, subclass 16.

Inventions I.-VI. are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as being used together and they have different modes of treating infarcted tissue zones. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art

because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Les Bookoff on 8/13/01 a provisional election was made without traverse to prosecute the invention of Group I., claims 1-24 and 42-44 readable thereon. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-41 and 45-77 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-21 and 42-44 are rejected under 35 U.S.C. 102(e) as anticipated by Melvin, US-6190408 or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melvin, US-6190408 in view of Alferness US-6165121. Melvin discloses a device (figs 4,6) for restructuring the heart chamber including internal (to the chamber) tension members and external anchors that in combination reduce the radius of curvature of the heart to treat dilation. Melvin is only lacking in that the device is not for treatment of a zone of infarcted tissue. It would appear however that even though infarcted tissue is not discussed by Melvin per se, such tissue would inherently be treated when the treated dilation is a direct result of an infarction, thereby making the treated tissue, or at

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least some of the treated tissue, infarcted tissue. In the alternative, Alferness teaches a totally external (to the heart) device for reshaping the heart in the treatment of dilation and further teaches that dilation can be a result of myocardial infarction (e.g. col. 1 at 23-26). Given the Alferness teaching to reshape the heart for dilation resulting from infarction, it would have been obvious to one having ordinary skill in the art at the time of the invention to have used the Melvin reshaping device to treat infarcted tissue as merely an alternative device for changing heart geometry. As to the exact positioning of the reshaping mechanisms of Melvin, changing the placement to optimize treatment efficacy would appear to be an obvious operational variant. It is noted that Applicants' application stems from parent applications filed earlier than Melvin, however these applications do not appear to address infarction, thus making the Melvin reference date applicable.

Allowable Subject Matter

Claims 22-24 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Jastrzab whose telephone number is (703) 308-2097. The examiner can normally be reached on Monday through Friday from 6:30am to 3:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angie Sykes, can be reached on (703) 308-5181. The fax phone number for this Art Unit is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Unit Analyst, Rosalind Smith whose telephone number is (703) 305-2440.


Jeffrey R. Jastrzab
Primary Examiner
Group 3762

August 14, 2001

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angie Sykes, can be reached on (703) 308-5181. The fax phone number for this Art Unit is (703) 305-3590.

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Jeffrey R. Jastrzab
Primary Examiner
Group 3762

August 13, 2001